

REMARKS

I. Prosecution History.

Claims 1-78 were originally submitted for examination with filing of the present patent application. Four groups of claims were identified in a four-way restriction, of which Applicant selected Group I, Claims 1-31, for examination. Claim 32-78 are restricted. All the elected claims, 1-31 are pending and stand rejected by the Examiner under 35 U.S.C. §102(e) and §103(a). More particularly, Claims 1 – 11 and 14 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,625,580 (hereinafter referred to as “*Tayama*”), while Claims 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Tayama* in view of U. S. Patent No. 6,076,167 issued to Borza (hereinafter referred to as “*Borza*”), and 13 and 15-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Tayama* in view of U. S. Patent No. 6,360,101 issued to Irvin (hereinafter referred to as “*Irvin*”).

In response, the applicant has amended Claims 1-2, 4-9, 13-19, 22, 25-32; and added new claims 79-104. Thus, claims 1-31 and 79-105 are presented for further examination.

II. Features of the Invention Summarized.

A reading of the present application will bring those skilled in the art to the understanding that the present invention is useful to handheld wireless device users that are mobile (e.g., traveling and/or in-between familiar or assigned enterprise data networks), have immediate requirements for a means to render (e.g., print, display, manipulate) electronic data on a device other than their wireless device, and are not familiar with locations of nearby data rendering devices capable of meeting the user’s requirements.

One important feature of the present invention is that a user can use his/her personal wireless device (WD) to locate a data rendering means (DRD) that has not been assigned to a WD and is in a fixed location that is accessible to wireless device users. Unassigned devices include printers, video displays, presentation projectors, Internet

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kiosks, ATMs, etc., that are made available to mobile wireless device users, e.g., installed in public terminals or within retail establishments.

Another important feature of the present invention is that wireless device users that are not near familiar (e.g., normally assigned as a resource for or dedicated to the wireless device) data rendering devices (e.g., such as those located in the user's home, office or corporate campus) can locate a user accessible data rendering device that has not already been assigned to the wireless device, and that can be used to render data associated with the user's wireless device (e.g., data in the wireless device memory or accessible from a mailbox at the direction of the wireless device).

Yet another important feature of the present invention is that wireless devices can be used to: control unassigned, user accessible data rendering device; manipulate data at the unassigned, user accessible data rendering device before or during data rendering; and check the operational readiness of data rendering devices before or during data rendering.

Public data networks and servers (e.g., telecommunications provider equipment) can be utilized to coordinate data rendering device location based on wireless device location, delivery of data to data rendering devices, and access to data rendering devices. Pass codes and encryption can be used to permit the rendering of data at rendering devices not assigned to the wireless device, and that are user accessible to the wireless device user before or during data rendering

Applicant's claims as amended fully support the above-described methods and capabilities and are supported by the extensive specification submitted by Applicant.

III. Rejection of Claims 1 – 11 and 14 under 35 U.S.C. §102(e) as being anticipated by *Tayama* (U.S. Patent No. 6,625,580).

Requirements for Prima Facie Anticipation

The Commissioner of Patents and Trademarks, acting through examining officials, bears the initial duty of supplying the factual basis supporting a rejection of a patent application, including a rejection based on anticipation. *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). The courts have interpreted this initial duty as placing on the Commissioner and the examiner the burden of

presenting a *prima facie* case of anticipation. *See In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986); *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (C.C.P.A. 1970). As stated by the Board in *In re Skinner*, 2 USPQ 2d 1788, 1788-9 (B.P.A.I. 1986), "[i]t is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office."

A general definition of *prima facie* unpatentability is provided at 37 C.F.R. §1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (emphasis added)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicant's claims, *Tamaya* must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicant need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i. e.*, show that *Tamaya* fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Application of Anticipation Requirements

With respect to the rejection of independent claims 1, the Examiner cites *Tamaya*, in conjunction with Col. 3, lines 50-67 and Col. 2, line 37-42, to support the proposition

that the aforementioned reference describes selecting data from a wireless device (WD) (goods input device) for rendering at a DRD (Display).

In actuality, *Tamaya* teaches a proprietary wireless device that is tailored for in-store assistance to retail shoppers. The *Tamaya* patent does not describe methods of locating and utilizing a data rendering means that has not been assigned to a wireless device and is located in a fixed location that is accessible to wireless device users. Applicant has amended his claims to better specify what is patentable over the cited art. For example, claim 1 now reads as follows:

1. A method of brokering data between handheld wireless devices and data rendering devices, comprising:

selecting data from a wireless device (WD) for rendering;

selecting a data rendering device (DRD) not assigned to said WD and located in a fixed location accessible by a WD user to render the data; and

providing the data to said DRD following commands entered by the WD user at said WD.

Tamaya does not describe systems, methods or processes that enable a mobile handheld wireless device user's to use his/her wireless device to locate data rendering devices that have not been previously assigned to the wireless device and are fixed at public locations that are accessible to wireless device users. *Tamaya* is specifically directed to an "order and delivery" system for use in a controlled, limited environment (e.g., a proprietary, closed, limited range network supporting communication between assigned equipment). Specifically, *Tamaya* specifically states that in the abstract that "[a] store system has a goods display area for displaying samples of goods and a goods storage area for stocking the goods . . . A customer holds a goods input device. The customer inputs data about the want-to-get goods through the goods input device. The goods data inputted are wirelessly transmitted to the goods indicator in the goods storage."

Furthermore, *Tamaya*'s input unit and display input are dedicated enterprise assets. The display unit is loaned to the shopper/user and is not meant to operate outside

of its fixed environment within the wireless boundaries of a store. The display unit, unlike wireless devices called for by Applicant in his specification, is also limited to proprietary "shopping" functions and is useless outside of its intended, dedicated environment located only within the "store."

Claims 2-11 and 14 depend from Claim 1. Claims 2, 4-9, and 13 have been amended to provide additional clarity and for consistency the amendment to claim 1.

Applicant respectfully asserts that claims 2-11 and 14 are allowable because they depend from independent Claim 1, which the applicant believes is patentable over *Tayama* for the reasons discussed *supra*. Applicant, therefore traverses the rejection of claims 1-11 and 14 and respectfully request reconsideration of these claims.

IV. Rejection of Claims 13 and 15-31 under 35 U.S.C. §103(a) as being unpatentable over *Tayama* in view of U. S. Patent No. 6,360.101 issued to Irvin.

Requirements for Prima Facie Obviousness.

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the examiner (assuming there are no objections or other grounds for rejection), an applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992).

Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met.

Application of the Obviousness Requirements to the Rejection of independent Claims 15 and 30.

Applicant respectfully asserts that the rejection herein fails under the third prong of the obviousness test because, for the reasons subsequently discussed *infra*, *Tayama*, either alone or in combination with *Irvin*, neither teaches nor suggests all of the limitations set out in independent Claims 15 and 30. Claims 15 and 30 are independent claims and have been amended to read as follows:

15. A method of brokering data between a wireless device and a data rendering device (DRD) not assigned to a wireless device (WD) and accessible to wireless device users, wherein a WD user performs the following steps at the WD:

selecting data for rendering data at a DRD;

entering a DRD locator request to find at least one DRD not assigned to the WD and accessible to the wireless device user;

receiving location information at said WD for the at least one DRD not assigned to said WD and accessible to the wireless device user;

selecting a DRD for rendering the data; and

requesting that the data be provided to said DRD.

30. A method of brokering data between wireless devices and data rendering devices,

comprising enabling a user of a wireless device (WD) to perform the following steps:

requesting support from a network supporting the WD to assist the user in locating at least one data rendering device (DRD) not assigned to the WD and accessible to the user of the WD, said locating executed by the network following at least one of commands by the user or in accordance with a WD profile located in at least one of the WD and/or the network;

selecting a DRD for rendering data;

selecting data for rendering at the DRD; and

providing data to the DRD for rendering.

Applicant contends that the rejections fail to satisfy the first prong because, in view of the objectives and teachings of the references, there is no motivation or suggestion to combine any of the cited references to provide the functionality and benefits to wireless device users as described and specifically claimed by Applicant in independent claims 15 and 30. In this regard, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Moreover, 35 U.S.C. §103(a) states that:

[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

It is thus improper for the Examiner to formulate the suggestion or motivation to combine prior art references based on current knowledge. As stated by the Federal Circuit Court in the opinion of *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. [The prior art fails] to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together

the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'

The foregoing comprises a caution against piecing together disparate and unrelated disclosures found in the prior art to meet a claimed structure, in the absence of any suggestion in the references implying the desirability of doing so. The applicants respectfully assert that, in view of the aforementioned guideline, combining *Tayama* with *Irvin* is improper and, therefore, a *prima facie* case of obviousness against Claims 15 and 30 cannot be established.

Application of the Obviousness Requirements to the Rejection of Claims 13 and 16-29 and 31.

The Examiner rejected dependent Claims 13, 16-29 and 31 under 35 U.S.C. §103(a) as being obvious over *Tayama* in view of *Irvin*. Claims 13-19, 22, 25-32 have been amended to provide clarification and in light of the amendments to independent claims 15 and 30.

Claims 13, 16-29 depend from Claim 15, and claims 31 and 32 depend from claim 30. Applicant believes that Claims 15 and 30 are patentable over *Tayama* for the reasons discussed *supra*. Therefore, Applicant respectfully asserts that claims 13, 16-29 and 31 are allowable because they depend from allowable independent Claims 15 and 30. Applicant, therefore traverses the rejection of claims 13, 16-29 and 31 and respectfully requests their reconsideration.

Application of the Obviousness Requirements to the Rejection of Claims 12.

The Examiner rejected dependent Claim 12 under 35 U.S.C. §103(a) as being obvious over *Tayama* in view of *Borza*. Claim 12 depends from Claim 1. Applicant believes that Claim 1 is patentable over *Tayama* for the reasons discussed *supra*. Therefore, Applicant respectfully asserts that claim 12 is allowable because it depends from an allowable independent Claims 1. Applicant, therefore traverses the rejection of claims 12 and respectfully requests its reconsideration.

IV. The addition of new dependent claims 79-105.

Applicant has added new claims 79-105 to the present case. No new matter has been added with the addition of claims. Claims 79-102 ultimately depend on independent Claim 1, and claims 102-105 ultimately depend on independent claim 30. Therefore, Applicant believes that the new Claims 79-105 are also patentable over *Tayama* for the reasons discussed *supra*. Applicant, therefore, respectfully asserts that new claims 79-105 be considered by the Examiner.

V. Other art – Tryding.

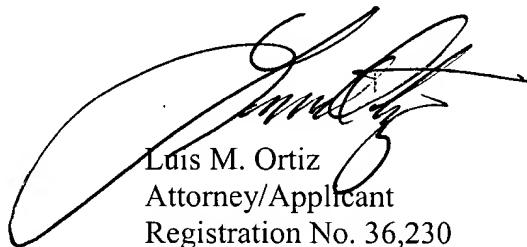
Applicant notes the citation of U.S. Patent No. 5,880,732, issued to Tryding. Tryding also does not describe the claimed features of Applicant's invention and is therefore not believed to bear on the allowability or patentability of the present invention as currently claimed.

VI. Conclusion

In view of the foregoing remarks, the applicants submit that Claims 11, 13-16, 21, 22, 25, 27, and 29-31 are patentably distinct over the references and in allowable form. Accordingly, the applicants earnestly solicit the favorable consideration of their application, and respectfully request that it be passed to issue in its present condition.

Should the Examiner discern any remaining impediment to the prompt allowance of the aforementioned claims that might be resolved or overcome with the aid a telephone conference, he is cordially invited to call the undersigned at the telephone number set out below.

Respectfully submitted,



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